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ARLEN L. OLSEN
SCHMEISER, OLSEN & WATTS
3 LEAR JET LANE
SUITE 201
LATHAM, NY 12110

EXAMINER	
LANIER, BENJAMIN E	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 10

Application Number: 09/383,691
Filing Date: August 26, 1999
Appellant(s): DELANEY, MICHAEL P.

Jack P. Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04 March 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-11, 13-22, 24-35 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,649,099	Theimer	7-1997
5,903,646	Rackman	5-1999

5,584,025 Keithley 12-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 13-21, 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer, U.S. Patent No. 5,649,099, in view of Rackman, U.S. Patent No. 5,903,646. Referring to claims 1, 6-9, 13, 16, 18-20, 24, 27-29, and 31, Theimer discloses a method for delegating server access rights executable access control program wherein the system comprises a server, client, a plurality of intermediaries (nodes), all connected to one another via communication network (Col. 7, lines 55-57). The server manages a resource (data object) to which the client has access rights (Col. 7, lines 59-61). The client and intermediaries are node computers comprising memory and one or more processors (Col. 8, lines 2-3). The server authenticates (security blocked) the client and each intermediary (Col. 9, lines 29-37). Requests are made from client or intermediaries to the server for a file (Col. 10, lines 14-20). The server then verifies (deciding to publish) that the client or intermediaries have the permission to perform this request. The server can call a function to check the permissions via an access list, check permission bits, or use other checking authorizations (Col. 11, lines 14-38). Theimer does not disclose that the resource (data object) includes attorney and client communications. Rackman discloses an access control

system for litigation documents wherein the documents stored on the data base contain confidentiality fields that control access to the specified documents to the attorney's associated with the documents (privileged communication between attorney-client)(Col. 7, lines 31-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include an confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).

Referring to claims 2, 17, 30, 32, Theimer discloses the intermediary (node), after server verification of rights, approving of the request (deciding to abandon or complete request)(Col. 18, lines 14-39).

Referring to claim 3, Theimer discloses the user having rights to read and write (edit) various files (Col. 2, lines 10-18).

Referring to claims 4 and 5, Rackman discloses the users being clients, attorneys or proper counsel (attorney-affiliate)(Col. 7, lines 45-49).

Referring to claims 10 and 21, Rackman discloses the file containing attorney-client communications being displayed over a monitor (visually)(Fig. 3, 12).

Referring to claims 14, 15, 25, 26, Theimer discloses limitation imposed by the server on the user accesses (previously published)(Col. 13, 32-43).

Referring to claims 33-35, it would have been obvious for the communications within the files to be between any set of person whom would want their communications kept confidential.

Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theimer, U.S. Patent No. 5,649,099, in view of Rackman, U.S. Patent No. 5,903,646 as applied

to claims 1 and 16 above, and further in view of Keithley, U.S. Patent No. 5,584,025. Referring to claims 11 and 22, Theimer discloses a method for delegating server access rights executable access control program wherein the system comprises a server, client, a plurality of intermediaries (nodes), all connected to one another via communication network (Col. 7, lines 55-57). The server manages a resource (data object) to which the client has access rights (Col. 7, lines 59-61). The client and intermediaries are node computers comprising memory and one or more processors (Col. 8, lines 2-3). The server authenticates (security blocked) the client and each intermediary (Col. 9, lines 29-37). Requests are made from client or intermediaries to the server for a file (Col. 10, lines 14-20). The server then verifies (deciding to publish) that the client or intermediaries have the permission to perform this request. The server can call a function to check the permissions via an access list, check permission bits, or use other checking authorizations (Col. 11, lines 14-38). Rackman discloses an access control system for litigation documents wherein the documents stored on the data base contain confidentiality fields that control access to the specified documents to the attorney's associated with the documents (privileged communication between attorney-client)(Col. 7, lines 31-52). Theimer does not disclose the resource (data object) being audio. Keithley discloses a server that distributes multimedia including video, and audio (Col. 5, lines 26-34). It would have been obvious to one of ordinary skill in the art for the resources (data objects) of Theimer to be audio files because distribution of audio files via servers is well known in the art.

(11) Response to Argument

Applicant's argument that the Rackman reference does not disclose whether the document contains a PCOM but rather discloses a level of confidentiality is not persuasive

because Rackman discloses that the litigation documents in question are stamped with "Bates number" identifications which identify redacted portions of the documents as being irrelevant or privileged based on the grounds of attorney client privilege (Col. 1, lines 14-22), which is interpreted to indicate attorney client communication or PCOM. These "Bates number" identifications and subsequent redacted portions of the documents can indicate whether the portion in question is confidential or not (Col. 9, lines 51-62). These litigation documents may contain not only subject matter of a particular lawsuit, but also unrelated matters (Col. 1, lines 65-67). So it is desirable to redact portions of these documents that are considered privileged (Col. 2, lines 3-8).

Applicant's argument that the Rackman reference does not disclose publishing a PCOM message if it is determined that a PCOM is included in the data object is not persuasive because Rackman discloses in Fig. 1 that a redacted document displays a confidentiality message (8b) when a portion of the document has been redacted. If we examine the figure further we see that redacted portion 8a is shown without a confidentiality message, while 8b contains both the confidentiality message along with its associated "Bates Number" (Col. 5, lines 5-27). This would indicate that a decision is made to publish a message and "Bates Number" at one portion of a document and not another.

Applicant's argument that the motivation to combine the Theimer and Rackman references is not persuasive because the Rackman reference does not disclose anything that could be used in Theimer to improve Theimer's invention is itself not persuasive because as mentioned in the original grounds of rejection, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the confidentiality permission bits disclosed in

Rackman with the access rights of Theimer so that the users, including attorneys, may distribute confidential documents as taught by Rackman (Col. 1, lines 29-59). It is an improvement on the system of Theimer in that it expands the user realm to include attorneys by adding access rights to the current system.

Applicant's argument that the Theimer and Rackman references do not disclose abandoning the request for access of the data object by the user of the node is not persuasive because it is well known that all computer system processes can be ended or abandoned easily. In the Unix operating system that is used in the Theimer (Col. 5, lines 6-12 & Col. 19, lines 24-27), users can end or abandon any computer process by using the kill command and the corresponding process identification (See Quick Reference: Unix Commands, Page 2). Further Rackman discloses that access to the confidential documents is controlled by the operating system (Col. 3, lines 22-23) therefore one of ordinary skill in the art would recognize the ability of a user to end or abandon their access request at any time.

Applicant's argument that no motivation has been provided to modify Theimer with the teaching of Rackman with respect to the preceding feature of claim 4 is not persuasive because the motivation was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include an confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).

Applicant's argument that the Rackman reference is silent with respect to client access rights is not persuasive because Rackman discloses that the confidentiality bits indicate whether

the client should be able to view the document (Col. 2, lines 22-27). The motivation was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include a confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).

Applicant's argument that no argument was presented relating to the features of claim 6 is not persuasive because claim 6 was addressed with its independent claim (1). From the present rejections (Page 2, paragraph 3):

> The server authenticates (security blocked) the client and each intermediary (Col. 9, lines 29-37). Requests are made from client or intermediaries to the server for a file (Col. 10, lines 14-20). The server then verifies (deciding to publish) that the client or intermediaries have the permission to perform this request.

This meets the limitation of wherein the user is not authorized to access the data object.

Applicant's argument that the Rackman reference does not disclose providing an input from the attorney as the whether the data object includes the PCOM, and wherein the determining includes a dependence on said input is not persuasive because Rackman discloses that the stamping and identification of the privileged portions of the documents is done be legal assistants and attorneys (Col. 1, lines 16-27). The stamping and identification would meet the limitation of an input that determines whether the document in question contains a PCOM.

Applicant's argument that the Rackman reference does not disclose ascertain whether the data object includes a phrase in a search list, and wherein the determining includes a dependence on a result of said ascertaining is not persuasive because Rackman disclose that the scanned using optical character recognition so as to identify a particular name or subject matter and the

stamping and identification of a subsequent match (Col. 1, lines 33-54), which meets the limitation of ascertaining whether the data object includes a phrase in a search list, and wherein the determining includes a dependence on a result of said ascertaining.

Applicant's argument that the Rackman reference does not disclose always determining that the data object includes the PCOM is not persuasive because Rackman discloses that when a document is being accessed the confidentiality bits are read to determine whether or not the user has access to the privileged information (Col. 3, line 30 – Col. 4, line 30). Which meets the limitation of always determining that the data object includes a PCOM.

Applicant's argument that the Rackman reference does not disclose visually displaying a PCOM message is not persuasive because Rackman discloses in Fig. 1 that a redacted document displays a confidentiality message (8b) when a portion of the document has been redacted. If we examine the figure further we see that redacted portion 8a is shown without a confidentiality message, while 8b contains both the confidentiality message along with its associated "Bates Number" which are displayed visually (Col. 5, lines 5-27). The motivation to combine was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include a confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).

Applicant's argument that the Rackman references does not disclose a deciding whether of not to publish a PCOM message is not persuasive because Rackman discloses in Fig. 1 that a redacted document displays a confidentiality message (8b) when a portion of the document has

been redacted. If we examine the figure further we see that redacted portion 8a is shown without a confidentiality message, while 8b contains both the confidentiality message along with its associated "Bates Number" which are displayed visually (Col. 5, lines 5-27). This would indicate that a decision is made to publish a message and "Bates Number" at one portion of a document and not another.

Applicant's argument with that the Rackman reference does not disclose that the decision to publish a PCOM message is based on whether the data object has been previously published is persuasive. The rejection of claims 14, 15, 24, 25 have been withdrawn.

Applicant's argument that no motivation was given in claim 17 to combine the Theimer and Rackman references is not persuasive. The motivation to combine was given in the preceding independent claim. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the permission bits in Theimer to include a confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's as taught by Rackman (Col. 1, lines 29-59).

Applicant's argument that the Theimer and Rackman references do not disclose a server coupled to the data object, an attorney node coupled to the server for enabling the attorney to interact with the data object, and a client node coupled to the server for enabling the client to interact with the data object is not persuasive because the Theimer reference discloses a server that can be a file server containing a resource (Col. 8, lines 30-53), which meets the limitation of a server coupled to a data object. The server can be coupled to multiple clients (Col. 8, lines 61-67), and as noted earlier it would have been obvious to one of ordinary skill in the art at the time

the invention was made for the to include the confidentiality permission bits disclosed in Rackman with the access rights of Theimer so that the users, including attorneys, may distribute confidential documents as taught by Rackman (Col. 1, lines 29-59). It is an improvement on the system of Theimer in that it expands the user realm to include attorneys by adding access rights to the current system. Therefore it would have been obvious that one of the clients could be an attorney since the improvement to Theimer is made to include attorneys as clients in the system.

Applicant's argument that the Theimer reference does not disclose that the client server is selected from the group consisting of a world wide web of the Internet, a wide area network, and a local area network is not persuasive because Theimer discloses that the client server module can be for example a wide area network or a local area network (Col. 8, lines 24-28).

Applicant's argument that the Examiner has not addressed whether it would be obvious to have status means for making a determination as whether the data object includes a PCOM between a psychotherapist and a client of the psychotherapist is not persuasive because in view of the current combination of Theimer and Rackman the combined system makes it possible to determine whether a document contains privileged communication between an attorney and a client and the Examiner stated that it would have been obvious for the communications within the files to be between any set of persons whom would want their communications kept confidential. Therefore communications involving a psychotherapist and a client of the psychotherapist would be obvious since communications of this distinction are considered confidential by law the same way attorney-client communications are considered confidential.

Applicant's argument with regards to PCOM between physician and a patient of the physician is not persuasive based on the reasoning directly above.

Applicant's argument with regards to PCOM between a husband and a wife is not persuasive based on the reasoning directly above.

Applicant defines the means of claims 16-28 in the specification (Page 3, line 20) as computer program means and computer programs are used to implement the systems in both Rackman (Col. 9, line 20) and Theimer (Col. 7, line 64 – Col. 8, line 7).

Applicant's argument that the motivation to combine that Theimer, Rackman, and Keithley references is an improper modification is not persuasive because Rackman discloses that confidentiality message, in text format, can be included on redacted portions of a document (Fig. 1), but Rackman does not disclose that the confidentiality message is in an audio format. Keithley discloses a server that distributes multimedia wherein an end user (client) can be delivered messages in an audio format (Col. 9, lines 51-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the text warnings of Rackman to be audio because audio warnings are just as well known in the art as text warnings. In fact most text based warning messages for all Windows operating systems are accompanied by an audio sound.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Benjamin E. Lanier
May 13, 2004

Conferees
Gilberto Barron
Kim Vu

GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

ARLEN L. OLSEN
SCHMEISER, OLSEN & WATTS
3 LEAR JET LANE
SUITE 201
LATHAM, NY 12110